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Supreme Court, U.S.
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No. 00-1134

IN THE
Supreme Court of the United States

PRIMETIME 24 JOINT VENTURE,

PETITIONER,

v.

NATIONAL FOOTBALL LEAGUE,

RESPONDENT.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

RESPONDENT'S BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether a satellite carrier based in the United States that captures and retransmits copyrighted telecasts in the United States for ultimate receipt abroad infringes the rights of the American copyright owner under the U.S. Copyright Act, 17 U.S.C. § 106(4).

RULE 29.6 STATEMENT

Respondent National Football League has no parent corporations; nor are there any publicly held companies owning ten percent or more of its stock.

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STATEMENT OF THE CASE

1. Respondent National Football League ("NFL" or "League") owns copyright in all NFL game telecasts. Pet. 1a, 10a. Petitioner PrimeTime 24 Joint Venture ("PrimeTime 24"), a New York-based satellite carrier, captured and retransmitted those telecasts in the United States for ultimate receipt abroad.

PrimeTime 24 makes "secondary transmissions" to users of satellite dish antennas of programming – including live telecasts of NFL games – of the CBS, NBC, ABC, and Fox television networks. Pet. 3. PrimeTime 24 captures and "uplinks" this programming to satellites for further retransmission to its subscribers abroad, including in Canada. Pet. 3.

The League has never granted PrimeTime 24 the right to sell or distribute telecasts of NFL games. Pet. 2a. By the time that the district court had entered its permanent injunction, PrimeTime 24, without authorization and despite repeated advance warnings, had retransmitted to its Canadian subscribers more than 100 NFL game telecasts. *See* Pet. 10a-11a.[1]

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[1] PrimeTime 24 has a limited *domestic* license, afforded by the Satellite Home Viewer Act ("SHVA"), 17 U.S.C. § 119, to retransmit network programming to certain "unserved households" in the United States. Two federal court decisions effectively prohibit PrimeTime 24 from retransmitting network programming, including NFL game telecasts, to unauthorized subscribers in the United States, *i.e.*, to those who are not "unserved households" within the meaning of the SHVA. *See CBS Broad., Inc. v. PrimeTime 24 Joint Venture,* 48 F. Supp. 2d 1342, 1357 (S.D. Fla. 1998) (permanent injunction based on finding that PrimeTime 24 had engaged in a "nationwide willful or repeated pattern or practice of infringements" and had made a "conscious decision to flout the law"); *ABC, Inc. v. PrimeTime 24 Joint Venture,* 17 F. Supp. 2d 467, 478, 490-91 (M.D.N.C. 1998) (permanent injunction based on finding that PrimeTime24 had "engaged in a willful or repeated pattern or (...continued)

2. In May 1998, the NFL filed a copyright infringement action against PrimeTime 24 in the United States District Court for the Southern District of New York. The district court denied PrimeTime 24's motion to dismiss, holding that "PrimeTime's first transmission of the signals, captured in the United States, from the United States, is necessarily a 'domestic predicate act [which is] itself an act of infringement in violation of the [United States] copyright laws.'" Pet. 31a.[2]

In September 1999, the district court granted the NFL's motion for summary judgment "(1) declaring that PrimeTime has violated NFL's rights under the Copyright Act by retransmitting NFL game telecasts of which NFL is the owner of the copyright to locations outside the United States [and] (2) permanently enjoining PrimeTime from making secondary transmissions of NFL game telecasts of which NFL is the owner of the copyright to locations outside of the United States. . . ." Pet. 22a.

The district court entered its judgment and permanent injunction in October 1999.

3. On April 28, 2000, a unanimous panel of the Second Circuit (Van Graafeiland, Straub, and Pooler, JJ.) affirmed. Pet. 1a-8a. After analyzing the relevant statutory language and case law, the court of appeals held that "a transmission need not be made directly to the public in order for there to be a public performance or display" and that "the most logical interpretation of the Copyright Act is . . . that a public performance or display includes 'each step in the

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practice" of transmitting domestic programming to ineligible households).

[2] The district court also held that the SHVA prohibits the unauthorized retransmission of domestic telecasts outside the United States. Pet. 33a-36a. *See* Part III, below.

process by which a protected work wends its way to its audience.'" Pet. 5a, 7a (citation omitted). The court concluded that "PrimeTime's uplink transmission of signals captured in the United States is a step in the process by which NFL's protected work wends its way to a public audience. . . . Because PrimeTime did not have authorization to make such a public performance, PrimeTime infringed the NFL's copyright." Pet. 7a.

The court of appeals denied rehearing *en banc*. Pet. 38a-39a.[3]

REASONS FOR DENYING THE PETITION

The petition should be denied. There is no meaningful conflict among the courts of appeals on the question presented. In any case, the decision of the Second Circuit is clearly correct, and its conclusion is amply supported by the language and legislative history of the Copyright Act and is consistent with appellate decisions from other circuits. Finally, the district court's holding that PrimeTime 24's retransmissions violated the Satellite Home Viewer Act provides an alternate ground for affirming the decision below and therefore for denying the petition.

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[3] On February 5, 2001, the district court awarded the NFL over $2.5 million in statutory damages for PrimeTime 24's infringements.

I. THERE IS NO CONFLICT THAT WARRANTS THIS COURT'S ATTENTION.

PrimeTime 24 fails to identify any meaningful legal conflict that must be settled by this Court. To warrant review, "there must be a real or 'intolerable' conflict on the same matter of law or fact, not merely an inconsistency in dicta or in the general principles utilized." Robert L. Stern, *Supreme Court Practice* § 4.3, at 167 (1993).

PrimeTime 24 fails to show a real conflict. Its entire "conflict" argument relies on an unexplained sentence of much-criticized *dictum* from a Ninth Circuit decision, which has not been followed even in that jurisdiction. On this basis alone, PrimeTime 24 asserts (Pet. 7-8) a conflict between the Second and Ninth Circuits on the issue of whether the unauthorized retransmission of copyrighted programming in the United States for ultimate receipt abroad violates the U.S. Copyright Act.

The Ninth Circuit case upon which PrimeTime 24 relies – *Allarcom Pay Television, Ltd. v. General Instrument Corp.*, 69 F.3d 381 (9th Cir. 1995) – primarily involved state law claims arising from the sale in Canada of tampered video descrambling devices. *See id.* at 384. Plaintiff, the exclusive provider of certain pay television services in western Canada, alleged that the U.S.-based defendants had engaged in unfair competition and had interfered with plaintiff's contracts by knowingly using and promoting the descrambling devices in Canada, thereby allowing viewers to bypass plaintiff's authorized service with programming transmitted from the United States. *Id.* at 383-84. Defendants argued that plaintiff's state law claims were preempted by the U.S. Copyright Act and should be dismissed. *Id.* at 387.

PrimeTime 24 points to a single sentence in *Allarcom* (Pet. 8) where the panel, rejecting the preemption argument,

suggested in *dictum* that receipt of the television signal is required for infringement liability to attach: "the potential infringement was only completed in Canada once the signal was received and viewed." *Id.* at 387. In offering this *dictum*, the court did not address the governing language of the Copyright Act, its legislative history, or any of the cases analyzed by the Second Circuit and discussed in Part II, below. The Second Circuit itself noted these shortcomings of the *Allarcom dictum*, expressly stating that it "accord[ed] the decision little weight largely because it contains no analysis of the Copyright Act." Pet. 7a.

The *Allarcom* panel did not even consider the possibility that uplinking copyrighted material to a satellite constitutes a complete act of infringement in the United States; instead, it simply assumed, based on the district court's characterization of the plaintiff's claims, that the act of transmission was either initiated here and completed abroad or was authorized here and took place abroad. 69 F.3d at 387. Relying on these flawed assumptions, the court held that U.S. copyright law did not apply to the conduct at issue and that, therefore, the plaintiff could proceed with its state law claims. *Id.*

The utter lack of any meaningful legal conflict – let alone an "intolerable" one – is demonstrated by the lack of deference paid to the *Allarcom* decision. In the five years since *Allarcom* was decided, no appellate court has followed its *dictum* suggesting that a satellite signal must be received and viewed in the United States before an infringement can occur here. [4] The only published Ninth Circuit decision to

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[4] As the Second Circuit recognized, the *Allarcom* case "has been subject to some non-judicial criticism." *See* Pet. 6a. For example, the case has been described as "a puzzling decision" that "promote[s] neither efficiency nor enforceability goals [and] appears to neglect concerns about the effective enforcement against unauthorized uses of copyrighted (...continued)

cite *Allarcom, Los Angeles News Service v. Reuters Television Int'l, Ltd.*, 149 F.3d 987 (9th Cir. 1998), *cert. denied*, 119 S. Ct. 1032 (1999), distinguished *Allarcom* on its facts.[5] Indeed, far from taking a position in conflict with the Second Circuit in *Los Angeles News Service*, the Ninth Circuit "adopt[ed] the Second Circuit's rule" that damages from international distribution of a copyrighted work are recoverable as long as at least one infringing act occurs in the United States. *See id.* at 992 (relying on *Sheldon v. Metro-Goldwyn Pictures Corp.*, 106 F.2d 45, 52 (2d Cir. 1939) (L. Hand, J.), *aff'd*, 309 U.S. 390 (1940), and *Update Art, Inc. v. Modiin Publ'g, Ltd.*, 843 F.2d 67, 73 (2d Cir. 1988)).[6]

In these circumstances, and in light of the Ninth Circuit's recent adoption of Second Circuit precedent in *Los Angeles News Service*, it is clear that the law in the Ninth Circuit is not settled, that it is not contrary to the law of the

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works." Andreas P. Reindl, *Choosing Law in Cyberspace: Copyright Conflicts on Global Networks*, 19 Mich. J. Int'l L. 799, 823 n.84 (Spring 1998). "Perhaps the best explanation for the result in *Allarcom* is that it was . . . based on . . . the court's preemption concerns: as the court found that the U.S. Copyright Act did not apply to the act of transmission, state law was not preempted. The plaintiff could therefore bring an action based on state unfair competition law." *Id.*

[5] Unlike in *Allarcom*, the works at issue in *Los Angeles News Service* were copied on videotape in the United States before being retransmitted abroad. 149 F.3d at 991. The Ninth Circuit was thus able to find infringement without having to analyze or resolve the issue of whether a satellite uplink of the same works in the United States would constitute a complete act of infringement here.

[6] PrimeTime 24 also cites the Ninth Circuit's unpublished one-page opinion in *Leisure Time Entertainment, Inc. v. Cal Vista*, 185 F.3d 867, 1999 WL 459579 (9th Cir. 1999). But that case had nothing to do with satellite retransmissions. It quotes *Allarcom* only for the undisputed proposition that, for the U.S. Copyright Act to apply, "at least one alleged infringement must be completed entirely within the United States." *See Leisure Time Entertainment*, 1999 WL 459579, at *1.

Second Circuit, and that there is no "real or intolerable" conflict warranting Supreme Court review.

II. THE DECISION BELOW PROPERLY APPLIED U.S. LAW AND IS CLEARLY CORRECT.

This case is not about misconduct in Canada; it is about illegal retransmissions in the United States. The issue is whether PrimeTime 24 violated U.S. copyright law by capturing and retransmitting in the United States for ultimate receipt abroad telecasts of football games played and broadcast in the U.S. The court below held that such conduct constitutes copyright infringement because it violates the NFL's exclusive "public performance" right under U.S. law.

The court of appeals' decision is plainly correct and is supported by (a) the plain language of the Copyright Act, which specifically includes transmissions within its definition of "public performance," (b) the Act's legislative history, which makes clear that "secondary transmissions" are within its scope, and (c) appellate decisions from the Second, Seventh, and Eighth Circuits, which confirm that secondary transmissions of the kind at issue here constitute "public performances" even though not received by the public until later in the transmission chain.

A. U.S. Copyright Law Governs Here.

The retransmissions at issue in this case originate and take place *in the United States* – not in Canada or anywhere else. The legality (or illegality) of PrimeTime 24's conduct under Canadian law therefore is not relevant.[7] As the district

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[7] Even if Canadian law were applicable, a direct conflict would arise only if PrimeTime 24 could not simultaneously comply with both U.S. and Canadian law. *See Hartford Fire Ins. Co. v. California*, 509 U.S. 764, 799 (1993) (no conflict where defendant can comply with laws of both countries). Here, PrimeTime 24 is asserting only that Canadian (...continued)

court correctly held, "[t]he copyrights which the Court has found have been infringed by PrimeTime are United States copyrights (and PrimeTime is a New York corporation with its principal place of business in New York . . .), and [there is] no reason why NFL should either be relegated to the expense and inconvenience of litigation in Canada, or limited to whatever royalties may be collectible from PrimeTime's Canadian distributors." Pet. 20a.

As this Court has stated, if more than one forum is available for a cause of action, "plaintiff's choice of forum should rarely be disturbed." *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 508 (1947); *see also, e.g., Olympic Corp. v. Societe Generale*, 462 F.2d 376, 378 (2d Cir. 1972) ("the balance must be very strongly in favor of the defendant, before the plaintiff's choice of forum should be disturbed, . . . and *the balance must be even stronger when the plaintiff is an American citizen and the alternative forum is a foreign one*") (emphasis added). For this reason, the plaintiffs in *Los Angeles News Service, Sheldon*, and *Update Art* (see page 6, above and page 14, below) were not required to sue in the foreign countries in which additional infringing conduct was occurring; instead, they exercised their right to sue in the United States, where a predicate infringing act had occurred. The NFL was entitled to the same choice.

B. The Second Circuit's Decision Correctly States The Law.

To establish infringement, "two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original." *Feist*

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permits what U.S. law forbids. *See id.* (no conflict where conduct is "perfectly consistent with [foreign] law and policy"). PrimeTime 24 can abide by the laws of both nations by refraining from its retransmissions from the United States.

Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991). "'[C]opying' is 'shorthand for the infringing of any of the copyright owner's five exclusive rights' set forth in Section 106 of the Copyright Act." 2 M.B. Nimmer & D. Nimmer, *Nimmer on Copyright* § 8.02[A] (2000) ("*Nimmer*") (citations omitted); *see also* 17 U.S.C. § 501(a) ("Anyone who violates any of the exclusive rights of the copyright owner . . . is an infringer of the copyright."). One such exclusive right is the right "to perform" the protected works "publicly" and to prevent others from doing so. Pet. 3a (citing 17 U.S.C. § 106(4)); *see also, e.g., National Football League v. McBee & Bruno's, Inc.*, 792 F.2d 726, 729 (8th Cir. 1986).

PrimeTime 24 does not dispute that the NFL owns valid copyrights in the more than 100 game telecasts at issue; the only dispute is over the legal question of whether its retransmission of the game telecasts violated the NFL's exclusive right to perform those game telecasts publicly.

The Second Circuit correctly held that, by capturing and retransmitting NFL game telecasts in the United States for ultimate receipt abroad, PrimeTime 24 infringed the League's exclusive public performance right:

> We believe the most logical interpretation of the Copyright Act is . . . that a public performance or display includes 'each step in the process by which a protected work wends its way to its audience.' . . . Under that analysis, it is clear that PrimeTime's uplink transmission of signals captured in the United States is a step in the process by which NFL's protected work wends its way to a public audience. In short, PrimeTime publicly displayed or performed material in which the NFL owns the copyright. Because PrimeTime did not have

> authorization to make such a public performance, PrimeTime infringed the NFL's copyright.

Pet. 7a.

The court of appeals' holding is supported – indeed, compelled – by the plain language and legislative history of the Copyright Act. As defined in the Act, the right "[t]o perform . . . a work 'publicly'" includes the right "to transmit or otherwise communicate a performance . . . of the work . . . to the public, by means of any device or process, whether the members of the public capable of receiving the performance . . . receive it in the same place or in separate places and at the same time or at different times." 17 U.S.C. § 101. Congress made clear that this definition is to be construed broadly to encompass not only the initial performance of a work, but also *any subsequent transmissions* of that work – including satellite retransmissions of the type at issue here. *See, e.g.*, H.R. Rep. No. 94-1476, at 63 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5676-77 ("a cable television system [publicly performs when it] . . . *retransmits* [a] broadcast to its subscribers. . . .") (emphasis added). [8]

The "public performance" definition thus encompasses the direct or indirect *transmission* of the signal to the public. For a public performance to occur, there need only be a transmission of a signal "capable" of being

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[8] The objectives of the Copyright Act are "accomplished by a structure of broad rights, carefully drafted limitations, and definitions of subject matter and 'copy' flexible enough to take into account new technologies." 1 William F. Patry, *Copyright Law and Practice* 521 (1994); *see also, e.g.*, H.R. Rep. No. 94-1476, at 62 (1976) ("The approach of the bill, as in many foreign laws, is first to state the public performance right in broad terms, and then to provide specific exemptions for educational and other nonprofit uses.").

received by the public; it is "not necessary that [persons] in fact attend or receive the performance" for a public performance to occur. *See* 17 U.S.C. § 101; 2 *Nimmer* § 8.14[C][1]-[2], at 8-188 to 8-191.

C. Decisions Of Other Federal Appellate Courts Confirm That The Court Below Was Correct.

PrimeTime 24's retransmissions to its satellites are plainly encompassed by the statutory definition. Although not transmitted directly to the public, they are "capable" of being received by the public later in the transmission chain. The federal courts have consistently held, as did the court below, that such indirect, intermediate transmissions constitute "public performances."

The Seventh Circuit, for example, confirmed that a satellite carrier "cannot be immune [from copyright liability] just because [it] does not retransmit [the station's] signal directly to the public . . . but instead transmits the signal to cable systems which retransmit it to their subscribers." *WGN Continental Broadcasting Co. v. United Video, Inc.*, 693 F.2d 622, 625 (7th Cir. 1982) (Posner, J.). The defendant satellite carrier was found to have infringed WGN's copyrights by "publicly performing" material that the station had broadcast, specifically by "pluck[ing] broadcast signals off the air, including signals from WGN, and transmit[ting] them to cable systems." *Id.* at 624-25. Analyzing the statutory language quoted above, Judge Posner squarely rejected the position taken by PrimeTime 24 here:

> We cannot find good textual support for the . . . position [that an intermediate satellite signal cannot serve as the basis for liability because it is not transmitted directly to the public]. The word 'public' does not appear either in the definition of secondary transmission or in the provision making the

> carrier of a secondary transmission liable unless passive. See 17 U.S.C. §§ 111(a), (f). It is true that WGN can complain only if United Video is interfering with its exclusive right to perform or display the copyrighted work publicly. 17 U.S.C. §§ 106(4), 106(5). *But the Copyright Act defines 'perform or display . . . publicly' broadly enough to encompass indirect transmission to the ultimate public. . . .*

Id. at 625 (emphasis added).

As an independent basis for the finding of infringement, the Seventh Circuit also relied on the so-called "passive carrier exemption," which "would be superfluous if intermediate carriers . . . could never be infringers anyway because they do not transmit directly to the public." *Id.*[9] Stated another way, if the public performance right were violated only when the transmission is *received* by subscribers, there would be no need to protect intermediate retransmitters with a statutory exemption.

The Eighth Circuit reached the same conclusion in *Hubbard Broadcasting, Inc. v. Southern Satellite Sys., Inc.*, 777 F.2d 393 (8th Cir. 1985). In *Hubbard*, the Eighth Circuit affirmed the district court's holding that secondary

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[9] The passive carrier exemption provides that a secondary transmission "is not an infringement of copyright if . . . the secondary transmission is made by any carrier who has no direct or indirect control over the content or selection of the primary transmission or over the particular recipients of the secondary transmission, and whose activities with respect to the secondary transmission consist solely of providing wires, cables or other communications channels for the use of others." 17 U.S.C. § 111(a)(3). Because PrimeTime 24 has control over the recipients of its secondary transmissions, it cannot (and does not) argue that it is a "passive carrier" exempted from liability.

transmissions are public performances "whether made directly or indirectly to the public and whether the transmitter originates, concludes or simply carries the signal. There is simply no practical basis for excluding certain transmitters from copyright liability based solely on their position in the distribution chain." 593 F. Supp. 808, 813 (D. Minn. 1984); *see* 777 F.2d at 401 (without passive carrier exemption, intermediate satellite carrier "liable for the unauthorized public performance of copyrighted material"). Any other construction "would render the passive carrier exemption § 111(a)(3) superfluous and wreak havoc with the compulsory licensing system of § 111(c)." 593 F. Supp. at 813.

D. It Is Of No Legal Significance That The Intercepted Telecasts Were Ultimately Viewed In Canada.

PrimeTime 24 attempts to distinguish these cases by arguing (Pet. 9-12) that the final destination of each transmission was the United States, not Canada. But "that makes no difference." Pet. 31a. The geographic point of receipt was not at issue in *WGN, Hubbard*, or any of the other cases. The question presented in those cases – and the question presented here – was whether intermediate transmission constitutes a public performance. Each and every court to address the issue has found that it does.[10]

Thus, the ultimate receipt of the game telecasts by viewers in Canada is irrelevant. The dispositive point is that PrimeTime 24's capture and retransmission of game telecasts

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[10] PrimeTime 24's reliance (Pet. 6-7, 10) on *Robert Stigwood Group Ltd. v. O'Reilly*, 530 F.2d 1096 (2d Cir. 1976), *De Bardossy v. Puski*, 763 F. Supp. 1239 (S.D.N.Y. 1991), *Gaste v. Kaiserman*, 683 F. Supp. 63 (S.D.N.Y. 1988), and *Goodman v. Lee*, 1994 WL 7107138 (E.D. La. 1994), is misplaced. None involved transmissions of any sort; rather, each involved alleged acts of preparation or authorization that preceded infringing conduct occurring wholly abroad.

occurred *in the United States* and constituted an act of infringement here.

For these reasons, PrimeTime 24 is simply wrong in attempting to characterize the Second Circuit's ruling as an "extraterritorial" application of the Copyright Act. Pet. 6-7. PrimeTime 24 – a U.S. enterprise, based in New York – captured and retransmitted in the United States telecasts of football games played in the U.S. and broadcast by U.S. network stations. In light of these undisputed facts, the Second Circuit correctly deemed irrelevant the ultimate receipt of the offending retransmissions outside (as well as within) the United States. *See* Pet. 6a-7a.

E. The Principles Underlying The Copyright Act Strongly Support The Second Circuit's Decision.

More broadly, the Second Circuit's decision is fully consistent with settled copyright principles. Even PrimeTime 24 would concede (*see* Pet. 6) that, had it made videotapes of the NFL game telecasts in the United States and shipped or retransmitted those tapes for rebroadcast in a foreign country, it would have been liable as an infringer in the United States. *See Los Angeles News Service*, 149 F.3d at 990-92 (9th Cir. 1998) (discussed in Part I, above).[11] In terms of both the statutory mandate and common sense, there is no distinction between such conduct and intercepting the telecast and retransmitting an electronic copy via satellite, as PrimeTime 24 did here.

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[11] *See also, e.g., Update Art*, 843 F.2d at 73 (2d Cir. 1988) (unauthorized reproduction of poster in U.S. followed by publication in Israeli newspaper constitutes infringement); *Sheldon*, 106 F.2d at 52 (2d Cir. 1939) (defendant liable for producing movie negatives in U.S. from which positives produced and distributed abroad).

There are sound policy reasons supporting these settled principles. It "does not make sense" for "everything [to] turn[] on the creation of a material copy within U.S. borders":

> The economic impact is the same – usurpation of foreign markets – whether defendant first makes an unauthorized reproduction in the United States, then distributes or transmits abroad, or whether it disseminates the work in dematerialized form, such as a satellite feed, from the United States to points outside.

Jane C. Ginsburg, *Extraterritoriality and Multiterritoriality in Copyright Infringement*, 37 Va. J. Int'l L. 587, 598 (Winter 1997). Where, as here, "it is possible to localize in the United States the point from which the communication of the infringing work (whether or not in material form) becomes available to the public (wherever that public be located), then U.S. courts should apply U.S. law to all unauthorized copies, wherever communicated." *See id.* at 600.

This approach is fully consistent with the resolution of this issue by other signatory countries to the Berne Convention.[12] The European Union's Satellite Directive provides that a copyright-triggering act of "communication to the public" occurs in the country from which the satellite signal is uplinked.[13] Consistent with this Directive, the

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[12] The Berne Convention is a multilateral copyright treaty to which "all the world's important countries now belong." 4 *Nimmer* § 17.01[B][1].

[13] *See* Council Directive 93/83/EEC (Sept. 27, 1993), 1993 O.J. (L 248) 15, art 2(b) (act of public communication occurs "solely in the Member State where, under the control and responsibility of the broadcasting organization, the programme-carrying signals are introduced (...continued)

United Kingdom's Copyright Tribunal has confirmed that a violation occurs when the signals are placed into an "'uninterrupted chain of communication leading to the satellite and down towards the earth.'" *British Sky Broadcasting Limited v. The Performing Right Society Limited,* 1997 WL 1105755, at 5.12 (Copyright Tr. Dec. 3, 1997). Accordingly, PrimeTime 24's position, which would bar suit in the country of transmission, would lead to the untenable situation where a copyright holder would have no forum to enforce its rights because, under the European Union approach, suit would also be barred in the country of receipt. *See* Ginsburg, *Private International Law Aspects of the Protection of Works,* supra, at 38.

Moreover, even if the countries of receipt were able to provide a cause of action, under PrimeTime 24's approach, a U.S. copyright holder would be required to file suit in each country – possibly scores of countries – in which the infringing transmissions are received. Congress clearly did not intend to impose such a burden on U.S. copyright holders where, as here, an infringing act has occurred in the United States. Indeed, "[w]ere it otherwise in a global marketplace, our copyright laws would be pointless." *Richard Feiner & Co. v. Turner Entertainment Co.*, 1998 U.S. Dist. LEXIS 1947, at *4 (S.D.N.Y. Feb. 24, 1998) (plaintiffs in U.S. courts are entitled to injunctive relief and damages for related infringements both here and abroad).[14]

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into an uninterrupted chain of communication"); *see also* Jane C. Ginsburg, *Private International Law Aspects of the Protection of Works and Objects of Related Rights Transmitted Through Digital Networks,* World Intellectual Property Organization, at 36-41, 44-45 (Nov. 30, 1998) (available at <http://www.wipo.int/eng/meetings/1998/gcpic/>).

[14] The proposed international treaty on the protection of audiovisual performances discussed at Pet. 14 relates to the granting of certain rights *to performers.* It has nothing to do with the scope of transmission rights or any of the issues raised in this case.

III. AN ALTERNATIVE BASIS FOR THE RESULT INDEPENDENTLY SUPPORTS DENIAL OF THE PETITION.

The district court correctly held that PrimeTime 24 also violated the express terms of the statutory license provided by the Satellite Home View Act ("SHVA"), 17 U.S.C. § 119. The court ruled that the SHVA, which is part of the Copyright Act, expressly "*prohibit[s]* satellite carriers . . . from capturing signals of network stations in the United States and transmitting them abroad." Pet. 35a-36a (emphasis added). Although the Second Circuit did not need to rely on the SHVA in reaching its conclusion, *see* Pet. 7a, the district court's holding provides an alternate basis for reaching the same result and thereby independently supports denial of the petition.

The SHVA grants a limited statutory license to satellite carriers to make "secondary transmissions" of network signals to a subscriber for "private home viewing" if, and only if, that subscriber resides in an "unserved household." 17 U.S.C. § 119(d)(10). The SHVA specifically provides that "[t]he statutory license created by this section shall apply only to secondary transmissions to households *located in the United States*." 17 U.S.C. § 119(a)(7) (emphasis added). Given that PrimeTime 24 is a "satellite carrier" making "secondary transmissions" of network signals to locations abroad, its conduct falls squarely outside the scope of the statutory license and is thus prohibited. Pet. 33a-36a.

The statute makes absolutely clear that this narrow compulsory license is the satellite carriers' *only* exemption from copyright infringement liability:

> No provision of section 111 of this title or any other law (other than this section [119]) shall be construed to contain any authorization, exemption, or license through

> which secondary transmissions by satellite carrier for private home viewing of programming contained in a primary transmission made by . . . a network station may be made without obtaining the consent of the copyright owner.

17 U.S.C. § 119(e) (1999); *see also id.* § 111(a)(4). The legislative history confirms that "a satellite carrier that retransmits . . . network stations for private home viewing . . . is exempted from copyright liability . . . *only if it secures a statutory license under section 119.*" H.R. Rep. No. 100-887, at 18, pt. 2 (1988) (emphasis added). Thus, Congress has provided in the SHVA – the very source of PrimeTime 24's authority – that, if a satellite carrier does not satisfy the precise terms of the statutory license, it is an infringer.[15]

That the SHVA prohibits the unauthorized retransmission of copyrighted works from the United States to other countries was confirmed recently by the Register of Copyrights in testimony before the House Subcommittee on Courts and Intellectual Property – testimony that was given *after* the Second Circuit had issued its opinion in this case. The Register confirmed that, under the Berne Convention, the United States "may not . . . permit retransmission [of television broadcasts] outside of its borders under a compulsory license." *Statement of the Register of Copyrights before the Subcommittee on Courts and Intellectual Property*

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[15] The district court's holding is further supported by settled rules of statutory interpretation. It is axiomatic that courts should "give effect, if possible, to every word Congress used," *Reiter v. Sonotone Corp.*, 442 U.S. 330, 339 (1979), and that, when Congress expresses one thing, it impliedly excludes others (*expressio unius est exclusive alterius*), *see, e.g., Greene v. United States*, 79 F.3d 1348, 1355 (2d Cir. 1996) ("mention of one impliedly excludes others").

of the House Committee on the Judiciary, at 15 (June 15, 2000) (available at <http://lcweb.loc.gov/copyright/docs/regstat61500.html>). This restriction is more than just confirmation that national copyright laws govern conduct within their respective territories; it is an affirmative limitation that requires member countries to impose and enforce territorial restrictions on the exercise of an author's retransmission right under a compulsory license. *Id.*

It is only by virtue of the SHVA that PrimeTime 24 has the right to retransmit NFL game telecasts at all. PrimeTime 24 cannot accept the benefits bestowed by the Act while at the same time acting as if its "geographic limitation," 17 U.S.C. § 119(a)(7), is devoid of meaning.[16]

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[16] *All* statutory terms "must mean something"; none should be construed so as to render them "superfluous, void or insignificant." *Triestman v. United States*, 124 F.3d 361, 376 (2d Cir. 1997) (citations omitted); *see also, e.g., United States v. Anderson*, 15 F.3d 278, 283 (2d Cir. 1994) ("courts will avoid statutory interpretations that render provisions superfluous").

CONCLUSION

The petition should be denied.

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